REMARKS

By the foregoing amendment, claims 43 and 44 have been amended to correct informalities as requested by the Examiner.

In the Office Action, claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22, 24, 25, 33, 39, 43 and 44 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,754,762 to Kuo et al. (hereinafter "Kuo"); and claims 2, 5, 7, 10, 13, 15, 18, 21 and 23 were rejected under 35 U.S.C. § 103 as allegedly being obvious over Kuo in view of U.S. Patent No. 5,870,601 to Getzlaff et al. (hereinafter "Getzlaff"). Claims 1-44 were rejected under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse the rejections of record.

Rejections under the judicially-created double patenting doctrine

Regarding the rejections under the double patenting doctrine, Applicants refer to the terminal disclaimer filed in this application on October 21, 2002. Applicants submit that this terminal disclaimer alleviates any potential double-patenting problem and respectfully requests that these rejections be withdrawn.

Rejections under 35 U.S.C. § 102(e)

With regard to the § 102(e) rejections of the independent claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22, 24, 25, 33, 39, 43 and 44, each of these claims recite that, in contrast to the Kuo reference, certain programming instructions loaded at the time of manufacture are not operational until subsequent storing of an address table (with memory addresses of at least one of said programming instructions) at the time of personalization. These claims further require: (1) the manufacture of an IC card including storage of programming instructions, but not including storage of an address

table with memory addresses of at least one of the programming instructions; and (2) the aforementioned address table is stored on the card during personalization of the card. One benefit is increased security by insuring that certain card use is prevented until the card is enabled at the personalization step with an address table to reference a particular set of loaded programming instructions or primitives (see, e.g., page 5, ¶ 00012).

Applicants have reviewed the Kuo reference, particularly the sections cited on pages 2-3 of the Office Action (col. 7. line 34 – col. 8 line 25), and are unable to find any mention or suggestion of an IC card which is manufactured with programming instructions which are not operational until subsequent loading of an address table at time of personalization. In particular, the cited portion of Kuo apparently only describes the use of an "operation flag," used to determine the operation of a bi-modal CPU, which provides a security measure when the IC card is utilized in conjunction with an external interface device and placed in communication with a system such as that operated by a banking institution. In other words, the Kuo reference clearly fails to disclose or suggest the present claimed invention of claims 1, 9, 17, 25, 33, 39, 43 and 44.

In addition, unlike the present claimed invention, the Kuo reference provides no motivation for providing a card system with the above-described features. As stated on page 11, ¶00030 of the specification, a benefit of the present invention is that it facilitates use of a card "despite an outdated codelet or primitive which may have been permanently placed in the card at the time of manufacture." In contrast, the methods taught in the cited reference are for the purposes of security during operation of commands during communication with an application provider such as a banking institution. (*see* col. 7, lines 34-42), and are completely unrelated to enabling the use of a

card despite an outdated codelet or primitive remaining on the card. Kuo makes no mention or suggestion of outdated codelets or primitives, much less whether it would be beneficial to use a card having such outdated codelets or primitives. Accordingly, it is clear that the present claimed invention is neither anticipated nor rendered obvious by Kuo, and at least independent claims 1, 9, 17, 25, 33, 39, 43 and 44 are in condition for allowance. Dependent claims 3, 4, 6, 8, 11, 12, 14, 16, 19, 20, 22 and 24 all depend from the base claims discussed above, and are accordingly also in condition for allowance.

Dependent claims 3, 6, 11, 14, 19, 22, 28, 30, 36 and 42 also recite the further limitation of programming instructions which comprise at least one codelet. Applicants are unable to find any mention of codelets anywhere in Kuo, and in particular, the section cited on pages 2-3 of the Office Action (col. 7. line 34 – col. 8 line 25) has nothing to do with storing codelets in the memory of a card. As noted above, the cited section of Kuo merely discusses a bi-modal CPU and an "operation flag" which provides a security measure when the IC card is utilized in conjunction with an external interface device, placing the card in communication with a system such as that operated by a banking institution. Furthermore, Applicants are unable to find any indication, anywhere in the cited reference, that storing a codelet would be useful for the bi-modal CPU described in Kuo. It is therefore clear that the cited reference neither teaches nor renders obvious the additional limitations recited in claims 3, 6, 11, 14, 19, 22, 28, 30, 36 and 42. Accordingly, because these dependent claims depend from allowable base claims, and recite further novel and non-obvious limitations, claims 3, 6, 11, 14, 19, 22, 28, 30, 36 and 42 should be allowed.

Rejections under 35 U.S.C. § 103(a)

Regarding the rejections of claims 2, 5, 7, 10, 13, 15, 18, 21 and 23 as allegedly obvious over Kuo in view of Getzlaff, Applicants respectfully traverse these rejections.

As noted by the Examiner, Kuo fails to disclose or fairly suggest that the instructions comprise a primitive. (*See* Office Action, p. 3). Getzlaff is likewise deficient in numerous respects. Getzlaff describes a data processing apparatus and method for correcting faulty microcode in a ROM device via a flag microinstruction in a RAM device which includes corrected microcode. (*See* Getzlaff, Abstract). As discussed at length above with respect to Kuo, Getzlaff likewise fails to disclose or suggest numerous elements recited in the independent claims from which claims 2, 5, 7, 10, 13, 15, 18, 21 and 23 depend, e.g., (1) programming instructions loaded at the time of manufacture are not operational until subsequent storing of an address table (with memory addresses of at least one of said programming instructions) at the time of personalization; (2) the manufacture of an IC card including storage of programming instructions, but not including storage of an address table with memory addresses of at least one of the programming instructions; and (3) the aforementioned address table is stored on the card during personalization of the card. Accordingly, because Kuo and Getzlaff viewed in combination fail to disclose or suggest numerous limitations of the claimed invention, Applicants respectfully submit that these claims are in condition for allowance.

Conclusion

Accordingly, in light of the foregoing discussion, it is submitted that claims 1-44, all of the pending claims, are in condition for allowance. Favorable reconsideration of these claims is therefore respectfully requested.

Respectfully submitted,

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